

RECEIVED

SEP 27 2004

Technology Center 2100

PATENT
0905-0216P

IN THE U.S. PATENT AND TRADEMARK OFFICE

Applicant: Atsushi TESHIMA Conf.: 7652
Appl. No.: 09/281,797 Group: 2155
Filed: March 31, 1999 Examiner: Philip B. TRAN
For: FONT SHARING SYSTEM AND METHOD, AND RECORDING
MEDIUM STORING PROGRAM FOR EXECUTING FONT
SHARING METHOD

REQUEST FOR REVIEW BY SUPERVISORY PRIMARY EXAMINER

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

September 24, 2004

Sir:

In accordance with the provisions of MPEP §707.02, Applicant respectfully request that the Supervisory Primary Examiner personally check on the pendency of the present application. This application has now received nine (9) Office Actions.

Prosecution History

On October 24, 2001, the Examiner issued an Office Action rejecting the originally filed claims 1-20 under 35 U.S.C. §102(b) as being anticipated by Flowers Jr., et al. (US 5,533,174). In an amendment dated January 24, 2002, Applicant cancelled the

originally filed claims 1, 5, 11-13, and 17-20, and added new claims 21-29.

In an Office Action dated April 9, 2002, the Examiner rejected claims 2-4, 6-10, 14-16, and 21-29 under 35 U.S.C. §102(b) as being anticipated by Flowers Jr., et al. In a reply dated July 8, 2002, Applicant traversed each the Examiner's rejection.

On August 20, 2002, Applicant's representative conducted a personal interview with the Examiner and the Primary Examiner, Patrice Winder, in response to the receipt of an Advisory Action dated July 24, 2002.

On September 6, 2002, Applicant submitted a Request for Continued Examination, that included a preliminary amendment in which Applicant made minor amendments to the claims in an effort to clarify the feature of "font preview data," as discussed during the personal interview.

In an Office Action dated November 21, 2002, the Examiner rejected claims 2-4, 6-10, 14-16, and 21-29 under 35 U.S.C. §103(a), as being unpatentable over Flowers Jr. et al. in view of Perry, "Teach Yourself WINDOWS 95," 1997. In response thereto, Applicant cancelled claims 3, 6, 9, 14-16, and 21-29, and added claims 30-35.

In a final Office Action dated May 8, 2003, the Examiner rejected claims 2, 4, 7-8, 10, and 30-32 under 35 U.S.C. §102(b) as being anticipated by Flowers Jr., et al., and rejected claims 33-35

under 35 U.S.C. §103(a) as being unpatentable over Flowers Jr., et al. in view of Mikuni (US 5,590,247). On August 6, 2003, Applicant amended independent claims 30-32 to include the subject matter of claims 33-35, respectively. Furthermore, Applicant specifically noted that the cited art, either alone or in combination, failed to teach the recited feature that box-shaped frames that enclose their respective characters are displayed on a display screen. The Examiner then mailed an Advisory Action on August 18, 2003, stating that Applicant's arguments were not persuasive.

On October 10, 2003, Applicant's representative conducted a second personal interview with the Examiner. Thereafter, Applicant filed a second Request for Continued Examination and an amendment, which merely clarified in the independent claims that the "display frames" are "display layout frames." Further, Applicant once again specifically noted in the Remarks section that "Mikuni does not display box-shaped frames that enclose a respective character, which are then displayed on a display screen," emphasis in original. In addition, Applicant specifically noted to the Examiner that the rectangular frames shown in Figs. 4-13 of Mikuni merely represent an arbitrary designated character string configuration region to arrange characters in predetermined areas, and that these configuration regions are not displayed.

On November 5, 2003, the Examiner issued a non-final Office Action, rejecting claims 2, 4, 7, 8, 10, and 30-32 under 35 U.S.C.

§103(a) as being unpatentable over Flowers Jr. et al. in view of Shimizu (US 6,189,020), which was newly cited by the Examiner. On February 4, 2004, Applicant submitted an amendment by clarifying the independent claims to recite that only layout frames are displayed in a preview area on a display screen. In addition to the amendment, Applicant explicitly referred the Examiner's attention to Fig. 8 and page 20, lines 14-17 of the specification of the present application and stated that "it can be readily seen that only layout frames (which enclose their respective characters) are displayed in the preview area A17 of the display screen," see page 11 of the reply dated February 4, 2004.

Thereafter, in a final Office Action dated April 16, 2004, the Examiner merely reiterated his previous arguments and ignored features of the claims by stating, for example, on page 13 of the Office Action that:

Flowers does not explicitly teach displaying in a preview area each of the frames are box-shaped such that each of the frames is able to enclose their respective characters that are represented by the data representing the sizes of characters. However, Shimizu in the same field of type-setting character font endeavor, discloses box-shaped frames for enclosing character string specifying fonts.

On July 8, 2004, Applicant's representative conducted a telephonic interview with the Examiner, and noted that the feature that only layout frames are displayed in a preview area of a display screen, as recited in the independent claims, was not

addressed in the Office Action that was mailed on April 16, 2004. Furthermore, Applicant's representative once again noted to the Examiner that this feature (that only layout frames are displayed in a preview area) is clearly shown in Fig. 8 of the drawings and is labeled as A17. The Examiner then issued an Interview Summary stating that the finality of the previous Office Action will be withdrawn and that a new Office Action will be issued.

On July 21, 2004, the Examiner mailed a non-final Office Action, which rejected claims 30-32 under 35 U.S.C. §112, first paragraph, whereby the Examiner alleges that the claims contain subject matter that "was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, has possession of the claimed invention." The Examiner further states on page 3 of this Office Action that the "[s]pecification does not explicitly describe nor is sufficiently clear for one of ordinary skill in [sic] art to recognize the following steps...to **display only layout frames** in a preview area on a display area screen....," emphasis in original

In addition, the Examiner also rejected claims 30-32 under 35 U.S.C. §112, first paragraph, stating that the claims contain "subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains...to make and use the claimed invention." The Examiner

attempts to rationalize the rejection by stating that "[u]ndue experimentation and ingenuity would be required beyond one ordinarily skilled in the art to...**display only layout frames** in a preview area on a display area screen..." emphasis in original.

The Examiner also rejected claims 2, 4, 7, 8, 10, and 30-32 under 35 U.S.C. §103(a) as being unpatentable over Flowers Jr. et al. in view of Shimizu, whereby the Examiner merely copied his previous rejection and once again failed to address the feature that only layout frames are displayed in a preview area.

SPECIFIC REQUEST

It appears to Applicant that the Examiner has misinterpreted relevant aspects of the present invention and fails to specifically address why the combination of the prior art would teach or suggest the feature that only layout frames are displayed in a preview area, as recited in the independent claims.

Furthermore, Applicant respectfully requests that the Supervisory Examiner review the Examiner's 35 U.S.C. §112, first paragraph, rejections. In particular because Applicant specifically directed the Examiner's attention to the preview area A17 in Fig. 8, which clearly shows that only layout frames are displayed. See also page 20, lines 13-17, and page 22, lines 11-16, of the present application. Thus, the specification clearly conveys to one skilled in the art that the inventors had possession of the invention,

because the specification expressly discloses the invention. Furthermore, one skilled in the art would not require undue experimentation and ingenuity to practice the feature that only layout frames are displayed in a preview area on a display screen.

As set forth in MPEP 706.07, "[t]o bring the prosecution to a speedy conclusion as possible and at the same time to deal justly by both the Applicant and the public, the invention as disclosed and claimed should be thoroughly searched in the first action and the references fully applied... It is to the interest of the Applicants as a class as well as to that of the public that prosecution of a case be confined to as few actions as is consistent with a thorough consideration of its merits."

MPEP §707.02 states that "the Supervisory Primary Examiners are expected to personally check on the pendency of every application which is up for the third or subsequent official action with a view to finally concluding its prosecution."

Accordingly, Applicant respectfully request that the Supervisory Primary Examiner acknowledge that the pendency of the present application has been personally checked in the next Office Action.

Conclusion

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully

requested to contact Martin Geissler (Reg. 51,011) at telephone number (703) 205-8000, which is located in the Washington, DC area.


If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. § 1.16 or under 37 C.F.R. § 1.17; particularly, extension of time fees.

Respectfully submitted,

BIRCH, STEWART, KOLASCH & BIRCH, LLP

By 

D. Richard Anderson, #40,439

 DRA/MRG:tm/fjl
0905-0216P

P.O. Box 747
Falls Church, VA 22040-0747
(703) 205-8000